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IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

SGS-THOMSON MICROELECTRONICS, INC.,
Cross-Petitioner,

v.

INTERNATIONAL RECTIFIER CORPORATION,
Cross-Respondent.

Cross-Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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CROSS-PETITION FOR A WRIT OF CERTIORARI

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August 23, 1995

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QUESTION PRESENTED

Whether a party that seeks a declaratory judgment of patent unenforceability based upon the patentee's alleged fraud on the patent office has a right to a trial by jury under the Seventh Amendment.

LIST OF PARTIES AND AFFILIATES

In addition to the parties listed in the caption, SGS-Thomson Microelectronics, S.r.l. (an Italian company) was a defendant in the district court; it was not a party in the court of appeals.

Pursuant to S. Ct. Rule 29.1, the following are the parent companies and non-wholly owned subsidiaries of SGS-Thomson Microelectronics, Inc.:

SGS-Thomson Microelectronics, N.V.
Thorn EMI plc
Thomson-CSF.

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IN THE

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No. 95-———

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Cross-Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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CROSS-PETITION FOR A WRIT OF CERTIORARI

SGS-Thomson Microelectronics, Inc. ("ST"), hereby submits this cross-petition for a writ of certiorari to the United States Court of Appeals for the Federal Circuit. This cross-petition is conditional upon the grant of the petition for a writ of certiorari filed by International Rectifier Corporation ("IR") on July 24, 1995, No. 95-143.

IR's petition in No. 95-143 presents two questions: (1) whether a party seeking a declaratory judgment of patent invalidity on the ground that the invention was not patentable under the patent laws has a right to trial by jury under the Seventh Amendment; and (2) whether a party seeking a declaratory judgment of noninfringe-

ment of a patent has a right to trial by jury under the Seventh Amendment. The United States Court of Appeals for the Federal Circuit in the decision below held that there was a right to trial by jury on such claims.

This cross-petition presents a related question: whether a party that seeks a declaratory judgment of patent unenforceability on the ground that the patentee committed fraud on the patent office has a right to try that claim to a jury under the Seventh Amendment. The court of appeals held that there was no right to trial by jury on that claim.

DECISIONS BELOW

The opinions of the district court and of the court of appeals are listed in the petition and opposition in No. 95-143. The opinions are reproduced in the appendices to those documents.

STATEMENT REGARDING JURISDICTION

On April 25, 1995, the United States Court of Appeals for the Federal Circuit issued an order in which it granted ST's petition for a writ of mandamus in part and denied it in part. ST had petitioned for a writ of mandamus to compel the district court to try ST's claims for declaratory judgments of patent invalidity, unenforceability, and noninfringement to a jury. The court of appeals granted the petition as to ST's claims based on invalidity and noninfringement, but denied ST's petition as to its claim for a declaration of unenforceability due to fraud on the patent office. On July 24, 1995, cross-respondent International Rectifier filed a petition for a writ of certiorari in this Court.*

This Court has jurisdiction over this cross-petition under 28 U.S.C. § 1254(1). The court of appeals had jurisdiction over ST's petition for a writ of mandamus under 28 U.S.C. § 1651. The district court had jurisdiction over this case under 28 U.S.C. §§ 1331, 1338.

* The petition in No. 95-143 was received by cross-petitioner on July 25, 1995. This cross-petition is therefore timely under S. Ct. R. 12.3.

As discussed in ST's opposition to the petition for certiorari in No. 95-143, ST believes that the question presented in that petition is moot. On July 5, 1995, after the court of appeals had entered the decision at issue in the petition and cross-petition, the district court dismissed this case without prejudice. Opp. App., No. 95-143, pp. 5a-7a. The dismissal was based upon the fact that the United States Patent and Trademark Office ("PTO") was engaged in reexaminations of the patents at issue in this case and had rejected each of the claims in those patents that are relevant to this case. Although, pursuant to the district court's dismissal order, the parties may move to reinstate the case following the PTO's reexamination proceedings, there is presently no case pending between the parties in the district court and, therefore, there is no Article III jurisdiction in this Court. *See* Opp., No. 95-143, pp. 5-6.

Should this Court conclude, however, that there is jurisdiction over the petition in No. 95-143, jurisdiction would similarly exist over this cross-petition.

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

The relevant Constitutional provision, U.S. Const., amend. VII, and the relevant statute, 28 U.S.C. § 2201(a), are reproduced in the petition. Pet., No. 95-143, p. 3.

STATEMENT OF THE CASE

ST respectfully refers to the petition and opposition in No. 95-143 for a complete statement of the case. One of ST's declaratory judgment claims in the district court asserted that IR's patents were unenforceable because the patentees had committed fraud on the patent office by intentionally failing to disclose material prior art during the prosecution of their patent applications. ST demanded a trial by jury on that claim, as well as on its claims for declaratory judgments that IR's patents were invalid and

not infringed. Following the district court's order striking ST's jury demand as to all claims, ST sought a writ of mandamus from the Federal Circuit asserting that it was entitled to a jury trial on all of its declaratory judgment claims. Although the court of appeals agreed that ST was entitled to a jury trial on its invalidity and noninfringement claims—the rulings that are at issue in the petition in No. 95-143—it held that ST's claim for a declaratory judgment of unenforceability was not triable as of right to a jury. In reaching this conclusion, the court relied entirely upon prior Federal Circuit decisions that had held that the question of fraud on the patent office was "purely equitable" and therefore a question for the court. Pet. App., No. 95-143, p. 4.

REASONS FOR GRANTING THE CROSS-PETITION

The petition in No. 95-143 seeks this Court's review of two questions concerning the right to trial by jury in patent litigation: whether the right to jury trial attaches to an action seeking a declaratory judgment of patent invalidity, and whether the right attaches to an action seeking a declaratory judgment of noninfringement. This cross-petition presents a closely related question: whether the right to trial by jury attaches to an action seeking a declaratory judgment that a patent is unenforceable because the patentee committed a fraud on the patent office. If the Court were to grant the petition in No. 95-143, it should grant this cross-petition for three reasons: (1) the issues presented in the petition and the cross-petition are closely intertwined in patent law—a claim that a patent is invalid is often closely related to a claim that the patent is unenforceable; (2) the historical inquiry required under the Seventh Amendment will simultaneously resolve the issues presented in both the petition and the cross-petition; and (3) the Federal Circuit's decision that an action seeking a declaratory judgment of unenforceability presents only equitable issues, not triable to a jury, is incorrect.

1. Under the patent laws, the factual determinations necessary to resolve claims of invalidity and unenforceability will frequently overlap. A party may seek a declaratory judgment that a patent is invalid because the claimed invention or process was not patentable under 35 U.S.C. §§ 100-104. In general, those grounds are that the claimed invention either was not new, 35 U.S.C. § 102, or was obvious "to a person having ordinary skill in the art to which the subject matter pertains," 35 U.S.C. § 103.

The claim that a patent is unenforceable because the patentee committed "fraud upon the patent office" (also known as "inequitable conduct") is a claim that arises out of the process of applying for patents. The PTO requires that applicants for patents submit to it all information "which is material to the examination of the application. Such information is material where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent." 37 C.F.R. § 1.56(a). To protect the integrity of the patent process and to encourage full disclosure by patent applicants, the courts have developed a doctrine under which, if it can be proven that a patentee intentionally concealed information important to whether the patent should have been issued, a court will enter a judgment barring the patentee from enforcing that patent.

The Federal Circuit has described the elements of a "fraud on the patent office" or "inequitable conduct" claim as follows:

> The doctrine of inequitable conduct requires a trial court to undertake a two-step analysis. The trial court must discern whether the withheld references satisfy a threshold level of materiality. The court must also determine whether the applicant's

> conduct satisfies a threshold showing of intent to mislead.

Halliburton Co. v. Schlumberger Tech. Corp., 925 F.2d 1435, 1439 (Fed. Cir. 1991); *see also Kingsdown Medical Consultants v. Hollister, Inc.*, 863 F.2d 867, 872 (Fed. Cir. 1988) ("Inequitable conduct resides in failure to disclose material information, or submission of false material information, with an intent to deceive, and those two elements, materiality and intent, must be proven by clear and convincing evidence."), *cert. denied*, 490 U.S. 1067 (1989).

Thus, a claim seeking a declaratory judgment that a patent is unenforceable due to inequitable conduct asserts that the patentee intentionally failed to disclose material information to the PTO. Because the only information that is material is information that bears on the question of validity, claims for declarations of unenforceability and invalidity are necessarily intertwined. Although, to prevail on a claim of inequitable conduct, a party need not demonstrate that the patent actually would not have issued had the withheld information been disclosed to the PTO (*i.e.*, that the patent is invalid), *see, e.g., Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1179 (Fed. Cir. 1995), claims of invalidity and unenforceability nevertheless generally rest on the same underlying facts. For example, in *Therma-Tru Corp. v. Peachtree Doors Inc.*, 44 F.3d 988 (Fed. Cir. 1995), the Federal Circuit recognized that, under *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 510-11 (1959), factual issues common to equitable claims and legal claims could not be tried to the bench and therefore instructed the district court to defer to the jury's findings on invalidity when considering related unenforceability claims.

2. The overlap between claims of invalidity and unenforceability in modern-day patent cases has its counter-

part in the procedural mechanisms available to resolve such claims under the English common law at the time of the adoption of the Seventh Amendment. As a result, the historical inquiry required under the Seventh Amendment to resolve the question presented by the petition in No. 95-143 is substantially the same as the historical inquiry required to resolve the question here, and a ruling on the petition would likely resolve this cross-petition as well.

The Seventh Amendment standard is well settled. The Seventh Amendment provides that "in suits at common law . . . the right of trial by jury shall be preserved." The fundamental inquiry is whether the suit, at common law, would have been tried to a jury. *Curtis v. Loether*, 415 U.S. 189, 193 (1974) ("the thrust of the Amendment was to preserve the right to jury trial as it existed in 1791").[1]

Here, the petition in No. 95-143 requires an inquiry into the action or actions available to a private party who sought to invalidate a patent in the English courts in 1791. The cross-petition requires an inquiry into the action or actions available in 1791 to a private party who sought relief in the English courts for fraud in the procurement of the patent. If this Court were to grant the petition, it should grant the cross-petition as well to permit both questions to be addressed and resolved in a single inquiry.

3. The Federal Circuit's decision that no jury trial right attached to an action seeking a declaratory judgment

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[1] The two-part *Tull* test—which inquires into the nature of the right and the remedy—is useful where the court is considering a new action (usually statutory) that did not exist in 1791. *Compare Tull v. United States*, 481 U.S. 412, 417 (1987); *Chauffeurs, Teamsters & Helpers Local No. 391 v. Terry*, 494 U.S. 558, 565 (1990). Where the action did exist at common law, and where there was a right to trial by jury in such an action in 1791, there is no need to deconstruct the action in the manner suggested by *Tull*.

that a patent was unenforceable due to inequitable conduct is clearly wrong. The court of appeals based its ruling on its own prior decisions holding that " 'inequitable conduct' is derived from the doctrine of unclean hands and is purely equitable in nature" and that therefore there was no right to trial by jury in an action seeking a declaratory judgment of patent unenforceability. *Gardco Mfg., Inc. v. Herst Lighting Co.*, 820 F.2d 1209, 1212 (Fed. Cir. 1987); *see also Paragon Podiatry Laboratory v. KLM Labs.*, 984 F.2d 1182, 1190 (Fed. Cir. 1993). Neither in those prior decisions nor in the decision below did the Federal Circuit conduct the historical analysis required by the Seventh Amendment.

That historical analysis yields an obvious and appropriate historical antecedent to an action for a declaratory judgment of unenforceability: an action for a writ of *scire facias*. At common law, a private party could bring an action for a writ of *scire facias* to assert that a patentee had committed a fraud upon the king and that the patent should not have issued. *See Ex parte Wood*, 22 U.S. (9 Wheat.) 603, 609 (1824) (Story, J.) (*scire facias* issued at common law "to repeal patents which have been obtained surreptitiously, or upon false suggestions"). Although a *scire facias* action was initiated in the Court of Chancery, the case was tried to a jury in a common law court. In fact, the Federal Circuit in *In re Lockwood*, 50 F.3d 966 (Fed. Cir.), *cert. granted*, 115 S. Ct. 2274 (1995), noted that the writ of *scire facias* would be the appropriate historical antecedent of an action for declaratory judgment based upon claims of inequitable conduct: "The contemporary analog of the writ [of *scire facias*] is thus an action for a declaration of unenforceability . . . ." 50 F.3d at 974 n.9. The Federal Circuit's failure to apply that insight in this case is inexplicable. *See* Pet. App., No. 95-143, p. 4.

In 18th-Century England, a party seeking to have a patent declared invalid or unenforceable would have

brought an action on a writ of *scire facias.* As this Court explained in *United States v. American Bell Telephone Co.*, 128 U.S. 315 (1888):

> Charters and patents authenticating grants of personal privileges were in the earlier days of the English government made by the crown. They were supposed to emanate directly from the king, and . . . the power of revoking them . . . was in the king, and was exercised by him as a personal privilege. This mode of revoking patents, however, seems to have fallen into disuse; and the same end was attained by the issue of writs of *scire facias*, in the name of the king, to show cause why the patents should not be repealed or revoked.

Id. at 360.

In the *Lockwood* case, the Federal Circuit noted the potential applicability of *scire facias*, but ultimately chose not to apply that historical analog because the court believed that the writ was available only to the king, and not to private parties. *See* 50 F.3d at 974 n.9. This belief, as Judge Nies properly noted in dissent from the denial of rehearing *in banc* in *Lockwood*, is unfounded. *See Lockwood*, 50 F.3d at 984 (Nies, J., dissenting).

Although a *scire facias* proceeding was brought in the name of the king, it was a remedy available as a matter of right to his subjects. The Court of the Queen's Bench held in *Brewster v. Weld*, 6 Mod. 229, 87 Eng. Rep. 980 (Q.B. 1704), that "if letters patents be to the prejudice of another, he may have a *scire facias*, upon the inrolment thereof in Chancery, to have them repealed, as well as the Queen may."[2] Blackstone further explained:

> [*Scire facias*] may be brought either on the part of the king in order to resume the thing granted; or, if

[2] *See also Underhill v. Devereux*, 2 Wms. Saund. 72, 85 Eng. Rep. 733 (K.B. 1671) (editor's notes) (noting that "the person prejudiced by the patent may, upon the enrollment of it in Chancery, have a *scire facias* to repeal it as well as the King").

> the grant be injurious to a subject, the king is *bound* of right to permit him (upon his petition) to use his royal name for repealing the patent in a *scire facias.*

3 William Blackstone, *Commentaries on the Law of England* *261 (emphasis added).[3] A leading commentator on patent law elaborates:

> A void or illegal patent for an invention, is in law prejudicial to every one of her Majesty's subjects, for it commands them to abstain from the use of the art or invention comprised in it. For this reason every person is presumed to have such an interest in a patent for an invention, that if he alleges that it is illegal or void, he is entitled as of right to a scire facias in the name of the Queen, in order to repeal it.

William M. Hindmarch, *A Treatise on the Law Relative to Patent Privileges for the Sole Use of Inventions* 385 (1847).[4]

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[3] *See also Sir Oliver Butler's Case*, 2 Ventr. 344, 86 Eng. Rep. 477 (1679) (holding that "where a patent is granted to the prejudice of the subject, the King of right is to permit him, upon his petition, to use his name for the repeal of it in *scire facias* at the King's suit").

[4] Some late 19th Century United States cases do hold that only the government can seek a declaration of patent invalidity. *See United States v. American Bell Telephone Co.*, 128 U.S. 315 (1888); *Mowry v. Whitney*, 81 U.S. (14 Wall.) 434 (1871). But, read carefully, those cases indicate that, in the English courts, a private party could initiate a suit to have a patent invalidated. That suit, as the cases acknowledge, was brought in the name of the king, but the king was required to lend his name to any person injured by the issuance of the patent. *See Mowry*, 81 U.S. at 440 ("[W]hen a patent is granted to the prejudice of the subject, the king of right is to permit him upon his petition to use his name for the repeal of it, in *scire facias* at the king's suit."); *American Bell Telephone*, 128 U.S. at 360 (noting that *scire facias* could be brought "in the name of the king").

The reason that *Mowry* and *American Bell Telephone* denied a private action for *scire facias* can be traced to the 1836 revision

In England in 1791, *scire facias* proceedings, although brought in chancery, were tried in a common law court. Blackstone explained that the English Court of Chancery consisted of

> two distinct tribunals: the one ordinary, being a court of common law; the other extra-ordinary, being a court of equity.
>
> The ordinary legal court is much more ancient than the court of equity. Its jurisdiction is to hold plea upon a *scire facias* to repeal and cancel the king's letters patent . . . .

3 Blackstone, *Commentaries* *47. "These legal proceedings [to invalidate a patent] were in the office called the 'Petty Bag,' the office of the court of chancery, in which all common-law proceedings of the court were carried on . . . ." *Attorney General ex rel. Hecker v. Rumford Chemical Works*, 32 F. 608, 618 (C.C.D.R.I. 1876). Although it was located within the Court of Chancery, the Petty Bag Office was a common law court, not a court of equity, and *scire facias* was a legal, not an equitable, action.

Because a *scire facias* brought in chancery was an action at law, the parties were entitled to have issues of fact tried by a jury. The anomaly that *scire facias* actions were initiated in the common law tribunal in the Court of Chancery, rather than in the King's Bench, in no way altered the parties' fundamental right to a jury trial. "On principle, the issues presented in a proceeding by *scire facias* must be triable in the same manner as like issues

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of the U.S. patent laws. Before that time, the patent laws provided that a private individual could seek a ruling of invalidity through *scire facias*. *See American Bell Telephone*, 128 U.S. at 371 ("Prior to the year 1836, from the earliest enactments of patent law, certain provisions had been incorporated in that law authorizing a *scire facias* . . . instituted by a private individual . . ."). The 1836 revision eliminated this private right of action. *See American Bell Telephone*, 128 U.S. at 371 ("The statute of 1836 repealed the provision for a *scire facias*.").

presented in other proceedings at law, and that the parties are entitled to a trial of issues of fact before a jury, if either so demands, is generally conceded." 24 Ruling Case Law, *Scire Facias*, § 22 (Eds. William M. McKinney & Burdett A. Rich, 1919); see also *Rumford Chemical Works*, 32 F. at 619 ("The only means which the law [of England] provides for the repealing of letters patent (for inventions) is by action of *scire facias* at the suit of the queen, and, as we have seen, this was a *quasi* common-law proceeding, with the right of trial by jury.") (citations omitted).

In fact, this Court has explicitly recognized that a *scire facias* sought on the basis that the patentee had committed a fraud upon the king was tried to a jury. "If a patent has been fraudulently obtained, or upon false suggestions, it may be repealed within three years, if a jury, upon a trial, shall be satisfied of the fact." *Ex parte Wood*, 22 U.S. (9 Wheat.) 603, 613-14 (1824) (Story, J.); *see also Mowry v. Whitney*, 81 U.S. (14 Wall.) 434, 439, 441 (1871). *Compare Lockwood*, 50 F.3d at 974 n.9.

However, the Chancellor, whose normal jurisdiction was in equity, was without power to summon a jury. Thus, if an issue of fact arose in a *scire facias* action, the Chancellor sent the case to the Court of the King's Bench, where the issue was then tried to a jury:

> [I]f any fact be disputed between the parties, the chancellor cannot try it, having no power to summon a jury; but must deliver the record *propria manu* into the court of king's bench, where it shall be tried by the country, and judgment shall be there given thereon.

3 Blackstone, *Commentaries* *48. In this manner, the parties' right to a jury trial was preserved.[5] *See also Rum-*

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[5] In *United States v. American Bell Telephone Co.*, 128 U.S. 315, 361-62 (1888), this Court cited *King v. Butler*, 3 Lev. 220, 83 Eng.

ford Chemical Works, 32 F. at 619 (a *scire facias* action "was a *quasi* common-law proceeding, with the right of trial by jury"); Neil Davenport, *The United Kingdom Patent System: A Brief History* 78 (1979) ("the validity of the patent was then tried, usually with a jury in the Court of the King's (or Queen's) Bench").

At the time of the Seventh Amendment, as a prominent early 19th-Century commentator noted, it was established in England that "the Court of Chancery never decides upon the validity of a patent, . . . if any question arises upon the validity of the patent, the novelty of the invention, or the sufficiency of the specification, it is uniformly referred to a court of law." John Davies, *A Collection of the Most Important Cases Respecting Patents of Invention and the Rights of Patentees* ix (1816). In the words of Justice Story, "[the procedure] to try the validity of the patent . . . is in the nature of a *scire facias* at the common law, to repeal patents, and the issues of fact, if any, are to be tried, not by the court, but by a jury . . . ." Joseph Story, *On the Patent Laws*, 16 U.S. (3 Wheat.) app. 13,

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Rep. 659 (H.L. 1685), a case in which the House of Lords declared that a *scire facias* in Chancery was the proper action for repealing a patent. After reviewing the *Butler* opinion, this Court concluded that "[t]he whole text of the answers of the judges in this case seems to imply that a jury was not necessary" in a *scire facias* action. *Bell Telephone*, 128 U.S. at 362. This was only true, however, because Butler's case presented no issues of fact. The House of Lords held that, since "the matter in the *sci. fa.* appear[ed] sufficient, and not denied by any plea of the defendant, but confessed by his demurrer, a judgment peremptory in Chancery ought to be given." *Butler*, 3 Lev. at 223, 83 Eng. Rep. at 661. Had the defendant properly asserted the validity of the patent, the issue would have been tried to a jury at King's Bench. *See* 2 Francis Stoughton Sullivan, *Lectures on the Constitution and Laws of England* 175 (1805) ("When, therefore, the cause was heard upon a *demurrer*, that is, the facts admitted of both sides, and only the law in dispute, [the Chancellor] gave judgment; but if they came to issue on a fact, he must carry the record over to the King's Bench, who summoned the jury, and gave judgment on the verdict.").

28 (1818); *see also Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 1013 (Fed. Cir. 1995) (*in banc*) (Newman, J., dissenting) ("These relationships were well established by the date of the Seventh Amendment. Issues of patent infringement and validity were tried only to a jury . . . .").

CONCLUSION

For the foregoing reasons, should the petition in No. 95-143 be granted, this cross-petition should be granted as well.

Respectfully submitted,

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